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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,094	09/25/2006	Venkatram P. Shastri	RCHP-139US	7026

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EXAMINER	
TENTONI, LEO B	
ART UNIT	PAPER NUMBER
1791	
MAIL DATE	DELIVERY MODE
06/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/594,094	SHASTRI ET AL.	
	Examiner	Art Unit	
	Leo B. Tentoni	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) *19-21* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18 and 22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 September 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *09252006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-18 and 22 in the reply filed on 16 April 2008 is acknowledged. The traversal is on the ground(s) that the claimed fibers of Group II are necessarily made by the process of Group I, and therefore the process of Group I is necessarily adapted to make the fibers of Group II. This is not found persuasive because the limitations in the claims of Group I fail to define a contribution over at least Kozlowski et al (U.S. Patent 4,054,625 A).

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 19-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 16 April 2008.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozlowski et al (U.S. Patent 4,054,625 A) in combination with Hsieh et al (U.S. Patent Application Publication 2004/0241436 A1).

Kozlowski et al (see the entire document, in particular, col. 2, line 32 to col. 8, line 25; Examples) teaches a process of making a fiber as claimed, except that Kozlowski et al does not teach making a fiber with an internal cavity (i.e., a porous fiber) or making a fiber having a diameter of at most 10 micrometers, which are both taught by Hsieh et al (see the entire document, in particular, paragraphs [0007], [0046] - [0049], [0058] - [0061] and [0093]) and would have been obvious to one of ordinary skill in the art at the time the invention was made in the process of Kozlowski et al in view of Hsieh et al principally in order to manufacture a polymer-based, porous nanofiber having

a high surface area. Furthermore, all of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time the invention was made (*KSR International Co. v. Teleflex Inc.*, 550 U.S. ____, 82 USPQ2d 1385 (2007)).

6. Claims 1-11 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozlowski et al (U.S> Patent 4,054,625 A) in combination with Miyamoto et al (U.S. Patent Application Publication 2006/0194036 A1).

Kozlowski et al (see the entire document, in particular, col. 2, line 32 to col. 8, line 25; Examples) teaches a process of making a fiber as claimed, except that Kozlowski et al does not teach making a fiber with an internal cavity (i.e., a porous fiber) or making a fiber having a diameter of at most 10 micrometers, which are both taught by Miyamoto et al (see the entire document, in particular, paragraphs [0017] - [0020], [0022] and [0040] - [0042]) and would have been obvious to one of ordinary skill in the art at the time the invention was made in the process of Kozlowski et al in view of Miyamoto et al principally in order to manufacture a nanofiber product having desired tear strength and flexibility. Furthermore, all of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known

methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time the invention was made (*KSR International Co. v. Teleflex Inc.*, 550 U.S. ____, 82 USPQ2d 1385 (2007)).

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (U.S. Patent Application Publication 2002/0100725 A1).

Lee et al (see the entire document, in particular, paragraphs [0022] and [0030]) teaches a process of making a fiber by electrospinning an emulsion, except that Lee et al does not specify the volume percent of the first and second components. However, the volume percent of the first and second components would have been obvious to, and readily determined by, one of ordinary skill in the art at the time the invention was made in the process of Lee et al principally because the volume percent of the first and second components depends on the properties desired in the fiber. Furthermore, one of ordinary skill in the art at the time the invention was made would have been motivated to modify Lee et al to achieve the claimed invention and there would have been a reasonable expectation of success (*KSR International Co. v. Teleflex Inc.*, 550 U.S. ____, 82 USPQ2d 1385 (2007)).

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (U.S. Patent Application Publication

2002/0100725 A1) in combination with Kozlowski et al (U.S> Patent 4,054,625 A).

Lee et al (see the entire document, in particular, paragraphs [0022] and [0030]) teaches a process of making a fiber by electrospinning an emulsion, except that Lee et al does not specify the volume percent of the first and second components. Kozlowski et al (see the entire document, in particular, col. 2, line 32 to col. 8, line 25; Examples) teaches a process of making a fiber including the volume percent of the first and second components, and such would have been obvious to one of ordinary skill in the art at the time the invention was made in the process of Lee et al in view of Kozlowski et al principally in order to manufacture a fiber having superior strength and other properties. Furthermore, all of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time the invention was made (*KSR International Co. v. Teleflex Inc.*, 550 U.S. ____, 82 USPQ2d 1385 (2007)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo B. Tentoni whose telephone number is (571) 272-1209. The examiner can normally be reached on Monday - Friday (6:30 A.M. - 3:00 P.M.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina A. Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leo B. Tentoni/
Primary Examiner, Art Unit 1791